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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/374,408 08/13/99 ANDREWS C ANDREWS-0080

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WM01/0327

EXAMINER

FOSTER, R

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 03/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/374,408

Applicant(s)

ANDREWS, CHRISTOPHER C.

Examiner

Roland G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

On page 3 of the response, filed on Feb. 23, 2001 as Paper No. 14, the Applicant remarks with respect to several independent claims that, "Bobo does not teach that the message are each stored and accessed at an independently accessible address."

Although the Applicant's remarks are duly considered, they are not deemed fully persuasive. The phrase "independently accessible address" is extremely broad. For example, a Uniform Resource Locator (URL) address of Bobo associated with the recorded audio file is an address "independently" accessible by any computer browser connected to the World Wide Web (WWW).

On page 5, paragraph 2 of the response, the Applicant remarks that, "dependent Claim 12 includes a further limitation to the method of Claim 1 specifying that a notification is sent to a user responsible for establishing the telephony connection".

Although the Applicant's remarks are duly considered, they are not deemed fully persuasive. The subject claims 1 and 12 are worded broadly enough to read on the normal use of a voice mail system. Bobo is a centralized voice mail system capable of supporting multiple mailboxes. One mailbox owner is perfectly capable of using the capabilities of Bobo to both record messages on other mailboxes served by the system and to receive notifications for incoming messages from anyone. This is analogous to

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using the capabilities your "office" voice mail system to record a message on a fellow office employee's mailbox served by the same voice mail system and who is out of the office. A mailbox owner that records a message for another mailbox owner via a telephone connection (responsible for establishing the telephony connection) may also receive a notification for messages incoming as well. However, the Applicant may wish to more narrowly recite the feature as disclosed in the specification of the instant application on page 8, lines 12-15. Bobo does not appear to teach this feature as it is disclosed by the Applicant's specification. However, a new search and/or consideration may be required upon submission of any proposed amendments.

On page 5, paragraph 4 of the response, the Applicant remarks with respect to claim 17 that, "Bobo does not teach that a recorded audio file is associated with a second file such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system."

Although the Applicant's remarks are duly considered, they are not deemed fully persuasive. The phrase "associated" is extremely broad. The message (recorded audio file) is "associated" with the e-mail file (second file) such that when the e-mail (second file) is accessed using the MSDS 10 (computer system), the message (recorded audio file) is available for playback because the e-mail file (second file) is sent when a message (recorded audio file) is received and available (see the abstract).

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On page 7, paragraph 3 of the response, the Applicant remarks with respect to claims 8 and 20 that, "Accordingly, within the system of Bobo there is no need, hint, teaching or suggestion to check for a user profile for the person leaving the message".

Although the Applicant's remarks are duly considered, they are not deemed fully persuasive. The subject claims 1, 8, 17 and 20 are worded broadly enough to read on the normal use of a voice mail system. That is, a subscriber can both record and receive messages by calling up the voice mail system (establishing a telephony connection). Not unexpectantly then, Bobo teaches that the incoming call are checked to determine if they are subscriber calls (col. 14, lines 31-40). This provide ample suggestion to check for a user profile for the person leaving the message, namely, to check to see if that person is a subscriber. If that person is not, then the person simply leaves a message in the normal fashion.

For the above reasons, the Applicant's remarks are not deemed persuasive the following rejections are repeated except where any new grounds of rejection is necessitated by amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-19, and 21-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Bobo, II (U.S. Patent No. 5,675,507) [Hereinafter Bobo].

With respect to claim 1, the following paragraphs for additional details on how Bobo anticipates particular limitations in the claim.

“a. establishing a telephony connection between a telephony device and a call recording device” reads on Figs. 1 and 2, where a telephone call (telephony connection) is established between Telephone Set (26) (telephony device) and a call recording device (Message Storage and Delivery System) (MSDS) (10).

“b. recording an audio communication transmitted over the telephony connection thereby establishing a recorded audio file” reads on Fig. 2, step (52).

“c. associating an independently accessible address with the recorded audio file, such that when the address is accessed using the computer system, the recorded audio filed is transmitted to the computer system for playback” reads on Fig. 1, Fig. 3, step

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(62), Fig. 8, and col. 7, lines 25-31 where the user enters a URL (address) at a Computer with a hypertext browser (32) (computer system) to access the MSDS (10). The URL (html address) is associated with the recorded audio file in that the URL is associated with the MSDS (10) mailbox where the recorded audio file is stored. The audio file is converted into a format appropriate for HTML linking, such as AU or WAV and transmitted to Computer (32) (computer system). See also col. 12, line 63 – col. 13, line 23. The phrase “independently accessible address” is extremely broad. For example, a Uniform Resource Locator (URL) address of Bobo associated with the recorded audio file is an address independently accessible by any computer browser connected to the World Wide Web (WWW).

Claim 17 differs substantively from claim 1 in that claim 1 recites the following limitation: “c. associating the recorded audio file with a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system”. This limitation reads on the e-mail file (second file) that is “associated” (a broad term) with the recorded audio file (message) in the sense that the e-mail (second file) is sent when a recorded audio file (message) is received and available (abstract).

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. “A. means for establishing a telephone connection...” reads on Fig.

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1, Telephone Set (26). "B. Means for recording..." and "C. Means for storing..." reads on Fig. 1, MSDS (10).

Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" to instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. Therefore, the claim 22 rejection for any further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. . Therefore, see the claim 1 rejection for any additional details. "a. a call processing and recording system..." reads on Fig. 13, Central Processor (3). "b. a server coupled to the call processing and recording system..." reads on Fig. 13, Internet Server (5). Note that Fig. 13 illustrates the various systems that comprise MSDS (10). See also col. 16, lines 47 – 67. "c. one or more computer systems..." reads on Fig. 1, Computer (32).

With respect to claims 2 and 18, see Fig. 13, Internet Server (5) and col. 17, lines 37-43.

With respect to claim 3, see Fig. 8 and col. 12, line 63 – col. 13, line 23. Note that the address (URL) is accessed when the audio file is retrieved.

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With respect to claims 4, 28, and 42, see col. 13, lines 10-15 where the user selects an anchor (hyperlink) to access a voice message (audio file). Although the anchor (hyperlink) may be a simple HREF command referring to the voice message (audio file), selecting the hyperlink would still result in the html address (URL) corresponding to user's mailbox on the Internet Server (5) being sent to Internet Server (5) in order for the browser to request and retrieve the voice message (audio file) from Internet Server (5).

With respect to claims 5, 25, 26, 33, and 34, see Fig. 1 where an Internet (data) connection is established between the Computer (32) and the MSDS (10) in order to play back recorded audio (col. 12, line 63 – col. 13, line 33).

With respect to claims 6, 29, 36, and 43, see col. 13, lines 10-15 and the claim 4 rejection above.

With respect to claims 7, 19, 24, 32, and 39, see Fig. 13 where the Internet Server (5) (server) is remote from the Computer (32) (computing system).

With respect to claim 9, the message storage process of Fig. 2 and message retrieval process of Fig. 3 are separated by time. The phrase "recorded audio file is first available for playback" is a broad term. For example, an audio file may be only considered "available" to the user when the user has established and Internet

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connection and successfully logged onto the MSDS (10) by entering a correct logon id and password. If the user is unable to log onto the MSDS (10), then the audio files are "unavailable" to the user.

With respect to claim 10, the user inherently has the ability to specify the "time" by simply deciding when to attempt to log onto the MSDS (10) (see the claim 9 rejection above) and review messages, such as immediately after the recording was made or after a lengthy delay period.

With respect to claim 11, a "location profile" is a broad enough phrase to correspond to the time zone that the MSDS (10) resides in because the time zone is a significant feature that helps to "profile" the location of MSDS (10). The time zone that the MSDS (10) is located in would in turn determine the "time" when remote users log onto the MSDS (10) from areas outside the time zone. As stated in the claim 10 rejection, the "time" that user logs onto the MSDS (10) specifies the range when the recorded audio file is first available for playback.

With respect to claim 12, see the abstract.

With respect to claim 13, see col. 8, lines 10-20 and col. 13, lines 16-18.

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With respect to claim 14, the link is posted in a predetermined location, namely in the MSDS (10).

With respect to claim 15, see col. 13, lines 13-14.

With respect to claim 17, see the abstract. Bobo is a centralized voice mail system capable of supporting multiple mailboxes. One mailbox owner is perfectly capable of using the capabilities of Bobo to both record messages on other mailboxes in the system and to receive notifications for incoming messages from anyone. This is analogous to using the inherent capabilities of the "office" voice mail system to record a message on a fellow office employee's mailbox who is out of the office. A mailbox owner that records a message for another mailbox owner via a telephone connection (responsible for establishing the telephony connection) may also receive a notification for messages incoming into the mailbox as well.

With respect to claims 23, 31, and 38, see Fig. 15, Storage (11).

With respect to claim 27, see Fig. 13, Internet Server (5).

With respect to claim 35, see Fig. 15, Storage (11) where the html files are addressed via the Internet (30).

With respect to claim 40, see col. 6, lines 20-22.

With respect to claim 41, see Fig. 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo as applied to claims 1 and 17 above.

Bobo fails to disclose checking for a user profile in a user database while the user is establishing a connection. However, a subscriber can both record and receive messages. Not unexpectedly then, Bobo teaches that the incoming call are checked to determine if they are subscriber calls (col. 14, lines 31-40).

Bobo also teaches that the user logs onto the system (establishes a connection) by entering a logon id and password (col. 7, lines 30-37). Bobo also teaches of a user database containing user profile information, such as the datalist.html file (col. 13, lines 24-33). "Official Notice" is taken the both the concept and advantages of checking to see if a user profile is located in a user database, especially during a logon process

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when determining the user's correct logon id and password, is extremely well-known and expected in the art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone numbers for this group are (703) 308-6306 and (703) 308-6296.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4800.

r.g.f. R.G.F.
March 16, 2001


SCOTT L. WEAVER
PRIMARY EXAMINER
Art Unit 2645